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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,846	08/25/2006	Masaharu Ueda	1551-0158PUS1	4142
2292 7590 06/28/2011 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER KIECHLE, CAITLIN ANNE				
ART UNIT 1733		PAPER NUMBER		
NOTIFICATION DATE 06/28/2011		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/590,846

Applicant(s)

UEDA ET AL.

Examiner

CAITLIN FOGARTY

Art Unit

1733

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 June 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(g).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 2, 17-20, 22 and 23

Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____

/ Roy King/
Supervisory Patent Examiner, Art Unit 1733

/CAITLIN FOGARTY/
Examiner, Art Unit 1733

Continuation of 11, does NOT place the application in condition for allowance because: Applicant's arguments are not persuasive.

Applicant argued that the cited art alone or in combination fails as a whole to suggest or disclose the precipitation of V-carbide, V-nitride, V-carbonitride, Nb-carbide, and Nb-carbonitride in austenite structure in a rail finish rolling. Even if the same or similar composition between the present invention and the cited art were to be hypothetically used, depending on the control of the specific conditions such as specific maximum rolling interval time (S), PC value and/or cooling rate when the temperature of the rail head is more than 700 degC, etc., the properties of the resulting rails vary. As seen in the examples in the instant specification, even if the composition and maximum head temperature are the same, when the maximum rolling interval time is different, ductility differs. Thus, it cannot be said that overlapping temperatures and compositions inherently precipitate V-carbide, V-nitride, V-carbonitride, Nb-carbide, and Nb-carbonitride in austenite structure in said rail during said finish rolling. In addition, Applicants submit that inherency cannot result from a combination of references, but rather must legally result from a single reference.

The Examiner's response is that the position taken in the previous Office action is maintained in that one of ordinary skill in the art would have expected the finish rolling step in the method of JP '914 in view of JP '075 or US '981 or JP'914 in view of US '685 to inherently precipitate V-carbide, V-nitride, V-carbonitride, Nb-carbide, and Nb-carbonitride in austenite structure in the rail as valimed since the methods of the prior art are substantially similar to the instant claimed method with overlapping temperatures and a steel rail composition that overlaps with the instant claimed composition. Applicant has not demonstrated the criticality of the maximum rolling interval time. The citation of a comparative example with S=1.2 sec is much higher than the claimed maximum of 0.7 and therefore does not demonstrate the criticality of the claimed range. In addition, criticality is not demonstrated for the minimum claimed S value of 0.10. It is recommended that Applicant compare values much closer to the claimed minimum and maximum ranges in order to demonstrate the criticality of the claimed S range. Furthermore, the prior art is not limited to the specific examples it teaches. See MPEP 2123. Rather, the Examiner relied on the broadest teaching of the prior art as discussed in the previous Office action. The Examiner also disagrees with Applicant's assertion that inherency cannot result from a combination of reference because there is nothing in the MPEP that leads to this conclusion.

Applicants also argued that it is noted that the claimed S refers to "the maximum rolling interval time when rolling passes are 3 or more." JP '914 or US '981 fails to specifically disclose the claimed specific S range of $0.10 \leq S \leq 0.70$ when rolling passes 3 or more. In fact the examples in the prior art are not within the claimed ranges. Thus, it is evident that the prior art referring to values outside of the claimed S range fail to recognize the significance or criticality of the claimed invention.

The Examiner's response is that JP '914 teaches in [0009] that the value of S is 10 seconds or less when the number of passes is 2 or more which overlaps with the instant claimed ranges of S and P. Similarly, [0202], [0204], and [0207] of US '981 disclose that S is not longer than 10 seconds when P is 2 or more which overlaps with the instant claimed ranges of S and P. In addition, the scope of the prior art is not limited to the specific embodiments it teaches. See MPEP 2123. Rather, the Examiner relied on the broadest teaching of the prior art as discussed in the previous Office action. In addition, Applicant has not demonstrated the criticality of S or P that is commensurate in scope with the instant claimed ranges and therefore the Examiner maintains the rejections in the previous Office action.